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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,880	11/03/2003	Daniel W. Jones	33244	2879

23589 7590 02/28/2005

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EXAMINER

DEPUMPO, DANIEL G

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/605,880

Applicant(s)

JONES ET AL.

Examiner

Daniel G. DePumpo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 27-39 is/are pending in the application.
- 4a) Of the above claim(s) 6,18,28 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,8-15,20,27,29,30 and 32-34 is/are rejected.
- 7) ☒ Claim(s) 4,5,7,16,17,19 and 35 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/26/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Applicant's election without traverse of Group I and species II (fig. 9, claims 1-5, 7-17, 19, 20, 27, 29, 30 and 32-39 readable thereon) in the reply filed on 12/16/04 is acknowledged. In the third paragraph of the remarks filed 12/16/04, applicant inadvertently indicated that claims 1-5, 7-17, 19, 20, 27, 29, 30 and 32-29 are readable on the elected species. It is clear, however, that this should be claims 1-5, 7-17, 19, 20, 27, 29, 30 and 32-39.

2. Claims 6, 18, 28 and 31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This claim recites that the "intercooler is positioned downstream of the supercharger and upstream of the engine". It is unclear whether the terms "downstream" and "upstream" are intended to define positions relative to the direction of travel of the vehicle, or positions relative to the flow path of combustion air. If applicant intends to refer to positions relative to the direction of travel of the vehicle, this recitation is inconsistent with the specification and drawings. For example, figs. 1 and 2 depict

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the intercooler 74 as being substantially forward of the supercharger. On the other hand, if applicant intends to refer to positions relative to the flow path of combustion air, it is unclear why this is the only structural limitation that is present in claim 9, because it is believed to be inherent that an intercooler, by definition, would be positioned downstream of the supercharger and upstream of the engine. Clarification and/or correction of this matter is required.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 3, 8, 10-15, 20, 27, 29, 30, 32, 33, 34, 36, 37 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Perry '463 (as cited by applicant on page 2, of the four page Information Disclosure Statement filed on 1/26/04).

Perry teaches a motorcycle having the structure as claimed. The device includes a supercharger 15 spaced forward of the crankshaft (fig. 21). The device further includes various endless elements (i.e. element 20, and the drive element under cover 60). The endless elements may be cogged as shown in fig. 19a. As shown in fig. 27, the device may include an indirect power take off component 18. As shown in fig. 7, the air induction system is outside of the leg-receiving areas 53. The device further includes a support bracket 23. It is considered to be inherent that the device includes foot supports.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2, 9 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perry in view of Applicant's Admitted Prior Art (APA).

As set forth above, Perry teaches substantially all that is claimed, but does not teach the claimed lubrication system or intercooler. However, as disclosed at pages 23 and 25 of applicant's specification, these features are known. It would have been obvious to use the claimed lubrication system, as taught by APA, to provide enhanced reliability. It would have been obvious to use in intercooler, as taught by APA, to provide enhanced performance.

10. Claims 4, 5, 7, 16, 17, 19 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Inoue discloses a device having features in common with the instant invention.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel G. DePumpo whose telephone number is 703 308-1113.

The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 703 308 1113. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel G. DePumpo
Primary Examiner
Art Unit 3611

dgd
2/22/05